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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,299	01/05/2001	Herman P. Taub	EHP0001-CON	3398

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EXAMINER	
KAZIMI, HANI M	
ART UNIT	**PAPER NUMBER**
3624	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,299	TAUB, HERMAN P.	
	Examiner	Art Unit	
	Hani Kazimi	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 January 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) *23,44,45,49 and 50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22,24-43,46-48 and 51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/5/01 and 2/4/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-51 are pending. The objections and rejections cited are as stated below:

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-22, 24-43, 46-48 and 51, drawn to the evaluation of individuals capabilities, classified in class 705, subclass 11.

II. Claims 23, 49 and 50, drawn to the evaluation of interventions and service providers, classified in class 705, subclass 1.

III. Claim 44, drawn to an apparatus for obtaining transcutaneous data, classified in class 600, subclass 345.

IV. Claim 45, drawn to an apparatus for obtaining brain wave data, classified in class 600, subclass 547.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

In the instant case the different inventions are never disclosed as being capable of use together. The evaluation of individuals has a different mode of operation form the evaluation of service provider and interventions.

4. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed evaluation process may be implemented without the use of an apparatus for obtaining transcutaneous data. The subcombination has separate utility such as a means for medical diagnosis.

5. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed evaluation process may be implemented without the use of an apparatus for obtaining brain wave data. The subcombination has separate utility such as a means for medical diagnosis.

6. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed evaluation process may be implemented without the use of an apparatus for obtaining transcutaneous data. The subcombination has separate utility such as a means for medical diagnosis.

7. Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed evaluation process may be implemented without the use of an apparatus for obtaining brain wave data. The subcombination has separate utility such as a means for medical diagnosis.

8. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Since this is a continuation application of application number 08/886,968, the same election made during a telephone conversation with Attorney George Marcou on Wednesday May 12, 1999 still applies to this application. A provisional election was made without traverse to prosecute the invention of Group I, claims 1-22, 24-43, 46-48 and 51. In replying to this Office action, Applicant must make affirmation of this election. Claims 23, 44, 45, 49, and 50 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

11. The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b). Appropriate correction is required.

12. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objection

13. Claim 51 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. Appropriate correction is required.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 5-19, 32-34 and 46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite an algorithm for defining behavioral capabilities or for identifying the relative stressor levels of mediated presentations. An algorithm "is a specific numerical process comprising a series of operations for arriving at a useful outcome"; however, there is no numerical process or series of operations disclosed. The disclosure should enable a skilled artisan to configure a computer/machine to possess the requisite algorithm, and, where applicable, interrelate the computer/machine with other elements to yield a useful outcome, without the exercise of undue experimentation. The specification fails to disclose any information about the "algorithm", how they are implemented or how it relates to the claimed process.

Further, one of ordinary skill in the art would not be able to supply the details of the algorithm, nor has a review of the prior art yielded any hint as to how to implement such apparatus.

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1-19, 22, 24-36, 38-42, 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "all roles and situations" renders the claim indefinite because the claim includes elements not actually disclosed (all possible roles and situations), thereby rendering the scope of the claim unascertainable.

Regarding claims 2, 5 and 24, the phrases "all roles and situations" and "all types" renders the claims indefinite because the claims include elements not actually disclosed (all possible types, roles and situations), thereby rendering the scope of the claims unascertainable.

Regarding claims 3-19, 22, 25-36, 38-42, 47 and 48, they are rejected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 101

18. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

19. Claims 1-22, 24-43, 46-48 and 51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The utility of an invention must be within the "technological" arts, i.e. an application of science and engineering to the development of machines and procedures in order to enhance or improve human efficiency. This may occur by having post-computer processing activity,

manipulating data to achieve a practical application, or through the claiming of a specific machine or manufacture. As claimed the Applicant's invention is not in the technical arts.

20. Claims 1-19, 21, 22, 24-43, 46-48 and 51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract ides or mathematical algorithm in the technological arts.

As claimed, Applicant's invention has no practical application in the technological arts. The claimed process or algorithm merely manipulates data pertaining to behavior capabilities with no reference to a practical application. However, if the claimed invention made reference to a practical application in the technological arts, such as using a computer for displaying the differences between attained abilities and required abilities to the user or generating a report profiling the users abilities versus the required abilities, the subject matter would be statutory.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Ostby et al (U.S. 5,326,270) disclose a method and apparatus for evaluating the task processing style of an individual.

-Driesener (U.S. 5,190,458) discloses a character assessment method.

-Brill (IJ.S. 5,435,324) discloses a method and apparatus for measuring a patient's psychotherapy progress.

-Swanson et al(U.S. 5,657,256) disclose a method and apparatus for administration of computerized adaptive tests.

-Lewis et al(U.S. 5,059,127) disclose a computerized mastery testing system based on Item Response Theory.

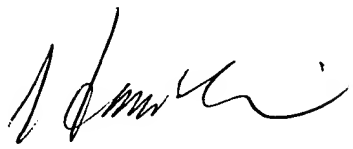
-Brunkow et al(U.S. 5,879,165) disclose a method for analyzing job performance and assessing multiple transferable skills.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

June 25, 2005